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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,151	02/04/2002	Manfred Schwartz	218469US0	9170

22850 7590 11/03/2003

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EXAMINER
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TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/061,151	<b>Applicant(s)</b> SCHWARTZ ET AL.	
	<b>Examiner</b> Elena Tsoy	<b>Art Unit</b> .1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                             | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>90203</u> . | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

Amendment filed on September 2, 2003 has been entered. New claims 16-20 have been added. Claims 1-20 are pending in the application.

***Specification***

1. The disclosure stands objected to because of the following informalities: examples of salts given on page 8, lines 21-42, page 9, lines 11-16, include oxides and hydroxides, which are **not salts**. Applicant is required to provide a clarification of these matters or correlation with art-accepted terminology so that a proper comparison with the prior art can be made.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-9, 11-15** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dattilo (US 6,291,018) and incorporated by reference McMonigal et al (US 5,196,485) in view of Murao et al (US 4,826,907) for the reasons of record as set forth in Paragraph No. 3 of the Office Action mailed on June 2, 2003.

4. **Claims 1-10, 14, 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 52093122 in view of Murao et al (US 4,826,907) for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on June 2, 2003.

5. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Dattilo (US 6,291,018) and incorporated by reference McMonigal et al (US 5,196,485) in view of Murao et al (US 4,826,907) for the reasons of record as set forth in Paragraph No. 3 of the Office Action mailed on June 2, 2003 since Dattilo teaches that the second basecoat may of any known acrylic resins (See column 4, lines 13-16, 29-43) such as those disclosed in incorporated by reference McMonigal et al, which have Tg of more than 20<sup>0</sup>C (See column 3, lines 8-25).

6. **Claims 18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dattilo (US 6,291,018) and incorporated by reference McMonigal et al (US 5,196,485) in view of Murao et al (US 4,826,907).

Dattilo, as described in Paragraph No. 3 of the Office Action mailed on June 2, 2003, fails to teach that the basecoat contains at least 5 %, 10 % or 15 % by weight of water. Dattilo teaches that after the first basecoat layer is applied, the coated substrate 12 preferably enters a first flash chamber 40 in which the air velocity, temperature and humidity are controlled to control evaporation from the deposited first basecoat layer to form a first basecoat layer with sufficient moisture content or "wetness" such that a substantially smooth, substantially level film of substantially uniform thickness is obtained without sagging (See column 7, lines 50-67). In other words, "wetness" limitations are result-effective parameters in a coating process.

It is held that it is not inventive to discover the optimum or workable ranges of result-effective variables by routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). See also In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined the optimum values of the relevant wetness parameters (including

those of claims 18-20) in Dattilo and incorporated by reference McMonigal et al in view of Murao et al through routine experimentation in the absence of a showing of criticality.

***Allowable Subject Matter***

7. **Claim 16** is allowed.

The following is an examiner's statement of reasons for allowance: Claim 16 is allowed because the prior art of the record does not teach or suggest the addition polymer P be prepared in the presence of anionic emulsifier. Closest prior art of Murao et al teach the addition polymer P prepared in the presence of nonionic surface-active agent.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

8. Applicants' arguments filed September 2, 2003 have been fully considered but they are not persuasive.

(A) Applicants argue that it is not clear why one skilled in the art would combine Murao et al with Dattilo or Ishikawa (JP 52-93122) and McMonigal et al, and even if combined the result would be not claimed invention because a coating composition of Murao et al is intended for protecting the **outside** surface of articles to prevent chipping.

The Examiner respectfully disagrees with this argument. One skilled in the art would combine Murao et al with Dattilo and McMonigal et al or Ishikawa for at least two reasons: one

of ordinary skill in the art at would have reasonable expectation of success in using the coating composition of Murao et al as a first coating and clear motivation to do so because the water-dispersible coating composition of Murao et al is similar to that of Dattilo or Ishikawa and, **when used for coating metal parts** of vehicles provides outstanding improvements in chipping resistance, **adhesion to a sheet metal, corrosion resistance**, flat film formability, anti noise property, gasoline resistance, **cold bending resistance** and impact strength, and also in the prevention of cratering or flash rusting during coating, and also in hot water resistance (See column 4, lines 24-37). Thus, clearly a coating composition of Murao et al can be used not only for protecting the **outside** surface of articles to prevent chipping but also as a first coating to provide **outstanding improvements in adhesion to a sheet metal, corrosion resistance**.

(B) Applicants argue that objection to specification should be withdrawn since Applicants intended the word "salt" to also include oxides and hydroxides.

The Examiner respectfully disagrees with this argument. Applicants cannot use the word "salt" for intended purpose because it would be so different from that which is generally accepted in the art to which this invention pertains (it is generally accepted in the art **not** to include oxides and hydroxides) that a proper search of the prior art cannot be made.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on Mo-Thur. 9:00-7:30, Mo-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

ET

Elena Tsoy  
Examiner  
Art Unit 1762

  
**MICHAEL BARR**  
**PRIMARY EXAMINER**

October 28, 2003